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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,844	03/18/2004	Jack Barron	B1037-700619	6441

37462	7590	10/05/2007
LOWRIE, LANDO & ANASTASI		
RIVERFRONT OFFICE		
ONE MAIN STREET, ELEVENTH FLOOR		
CAMBRIDGE, MA 02142		

EXAMINER	
CLOUD, JOIYA M	

ART UNIT	PAPER NUMBER
2144	

NOTIFICATION DATE	DELIVERY MODE
10/05/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ll-a.com
gengelso@ll-a.com

Office Action Summary

Application No.

10/803,844

Applicant(s)

BARRON, JACK

Examiner

Joiya M. Cloud

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the application filed on March 18, 2004. Claims 1-18 represent Communication through a financial services network.

Objections

2. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited, and "said *The form and legal phraseology often used in patent claims~ such as "means", " should be avoided.* The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Drawings

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings contain informal elements, such as hand drawn elements and also does not provide a descriptive textual label for each numbered element (for example, Figures 1-3) Applicant is advised to employ the services of a competent patent draftsman

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outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings.

The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-18 provisionally rejected on the ground of nonstatutory double patenting over claims 1-18 of copending Application No. 10/993198. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common

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subject matter, as follows: Exemplary Claim 1: *A method of communicating a message from a sender to a recipient in possession of a unique identifier by use of which the recipient can perform a transaction at a transaction terminal, the method comprising: receiving the message from the sender, the message including a reference to the unique identifier; storing the message in a computer memory; detecting performance by the recipient of a transaction at the transaction terminal; and transmitting the message from the computer memory in which it is stored to the transaction terminal for display to the recipient incidental to the transaction performed, the message being independent of the transaction performed.*

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1- 18** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kirschner et al. (US Pub. No. 2004/0010597 A1)

As per claim 1, Kirschner teaches a method of communicating a message from a sender to a recipient in possession of a unique identifier by use of which the recipient can perform a transaction at a transaction terminal, the method comprising: receiving the message from the sender (**Abstract, Figures 9, item 306 and Figure 11**), the message including a reference to the unique identifier (**paragraph [0031] and [0035]**); storing the message in a computer memory; detecting performance by the recipient of a transaction at the transaction terminal (**paragraph [0035]**); and transmitting the message from the computer memory in which it is stored to the transaction terminal for display to the recipient incidental to the transaction performed, the message being independent of the transaction performed (**Figure 11, item 352, Figure 7, item 160, paragraph [0039]**).

As per claim 2, Kirschner teaches a method further comprising: storing the unique identifier in a transaction token having memory therefor (**paragraph [0035]**).

As per claim 3, Kirschner teaches a method further comprising: transmitting the unique identifier from the transaction terminal to a transaction processor in communication with the memory; and searching the memory for the message using the reference to unique identifier to find the message (**Figure 11, items 348-356**).

As per claim 4, Kirschner teaches a method wherein the unique identifier is a transaction card number (**paragraph [0031]**).

As per claim 5, Kirschner teaches a method further comprising: transmitting a limited use identifier mapped to the unique identifier from the transaction terminal to a transaction processor in communication with the memory; determining, by a reverse mapping, the unique

identifier; and searching the memory for the message using the unique identifier to find the message (**Figure 11, items 348-356**).

As per claim 6, Kirschner teaches method wherein receiving further comprises: receiving input to a computer through a browser interface (**paragraph [0083]**).

As per claim 7, Kirschner teaches a method wherein the reference to the unique identifier includes a name by which the recipient is known (**paragraphs [0098] and [0106]**).

As per claim 8, Kirschner teaches a method wherein the reference to the unique identifier is an e-mail address (**paragraph [0113]**).

As per claim 9, claim 9 is substantially the same as claim 1, but in computer-implemented method form rather than method form and thus is rejected using similar rationale.

As per claim 10, claim 10 is substantially the same as claim 1 and thus is rejected using similar rationale. Furthermore, regarding transmitting the telephone number for the message retrieval system to which the message has been transmitted to the transaction terminal for display to the recipient incidental to the transaction performed (**paragraph [0057] and [0032]**).

As per claim 11-17, claims 11-17 are substantially the same as claims 2-8 and thus are rejected using similar rationale.

As per claim 18, Kirschner teaches an apparatus for communicating a message from a sender to recipient in possession of a unique identifier by use of which the recipient can perform a transaction at a transaction terminal, the apparatus comprising: a first communication network (**Figures 3 and 9**); a second communication network including a transaction terminal (**Figures 3**

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and 9); a computer memory (**Figures 3 and 9**); one or more processors collectively executing a sequence of instructions defining functions of: receiving the message over the first communication network; storing the message in the memory; detecting performance by the recipient of a transaction at the transaction terminal; and transmitting the message over the second communication network (**Figures 3 and 9**).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

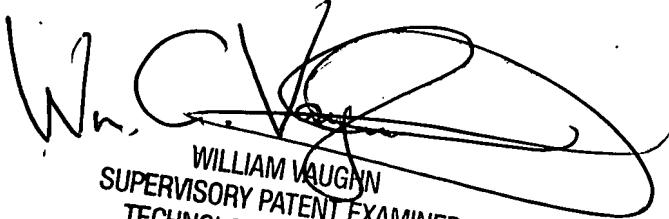
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3922. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMC

William C. Vaughn

Supervisory Patent Examiner

September 18, 2007


WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100